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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 10/617,965   | 07/11/2003  | Hung-Yang Chang      | YOR920030197US1<br>(8728-627) | 4134             |
| 46069  | 7590        | 08/24/2006           | EXAMINER                      |                  |
| F. CHAU & ASSOCIATES, LLC<br>130 WOODBURY ROAD<br>WOODBURY, NY 11797 |             |                      | JEANTY, ROMAIN                |                  |
|  |             |                      | ART UNIT                      | PAPER NUMBER     |
|  |             |                      | 3623                          |                  |

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/617,965 | <b>Applicant(s)</b><br>CHANG ET AL. |  |
|                              | <b>Examiner</b><br>Romain Jeanty     | <b>Art Unit</b><br>3623             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 21-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Election/Restriction**

1. Applicant's election with traverse of claims 1-38 in the reply filed on May 2, 2005 is acknowledged. The traversal is on the ground(s) that simultaneous examination of groups I and II will not present a burden on the examiner. This is not found persuasive because even though Group I and II belong in the same subclass, it presents a burden on the examiner because invention of Group II has limitations that are different from invention of Group I, which must be searched. Therefore, the requirement is still deemed proper and is therefore made FINAL.

Claims 1-20 are present in the application to be examined. See rejection below.

### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts of:
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, invoice, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Furthermore, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

While claim 1 produces a useful, concrete, and tangible result, they are deemed to be statutory for failure to apply, involve, use, or advance the technological arts. In order to overcome this rejection, it is respectfully suggested that the claims be amended to expressly incorporate technology (i.e., a computer processor) as performing at least one of the steps of the invention. Appropriate correction is required.

Claims 2-10 depend from claim 1; therefore claims 2-10 are rejected under the rationale relied upon of claim 1.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Stowell et al (20020099579).

As per claim 1, Stowell discloses an event-monitoring architecture for performance-based supply chain management method. In so doing, Stowell et al disclose executing a business process that comprises an integrated set of applications that enable interactions between a plurality of entities (i.e, an application for processing [Paragraph 0031], and managing the execution of the business process using business commitment specifications that describe one or more business commitments among said entities [Paragraph 0036 and 0093], wherein the business commitments are defined using KPIs (Key Performance Indicators) [Paragraph 0085, and 0102].

Stowell et al disclose all of the limitations above but fail to disclose and wherein KPIs are defined using probe points. Official Notice is taken is taken that it is old and well known in the art KPI (Key Performance Indicator) to define probe points. It would have been obvious to a person of ordinary skill in the art to modify the teachings of Stowell et al to include probe points in order to locate business elements within a business process order to specify commitments in the context of business process management.

As per claim 2, Stowell further discloses wherein the business commitment specifications are described using XML (eXtensible Markup Language) syntax [Paragraph 0027].

As per claim 3. Stowell et al does not expressly disclose monitoring a probe point associated with the business process, and determining a value of a KPI when a probe point, which is associated with the KPI, is activated. Official Notice is taken is taken that it is old and well known in the art to monitor a probe point associated with a business process, and

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determining a value of a KPI when a probe point, which is associated with the KPI, is activated. It would have been obvious to a person of ordinary skill in the art to modify the teachings of Stowell et al to include this well known teachings in order to locate business elements within a business process order to specify commitments in the context of business process management.

Stowell et al further disclose evaluating a business commitment associated with the KPI based on the determined value of the KPI to determine if the business commitment has been violated. [0093]

As per claim 4. Stowell et al further disclose wherein the step of determining a value of a KPI comprises determining the value of the KPI based on a value of at least one other KPI [Paragraphs 0014, 0055 and 0152].

As per claim 5. The method of claim 3, wherein the step of determining a value of a KPI comprises invoking a function to determining the value of the KPI [Paragraph 0114]

As per claim 6, Stowell et al further disclose the concept of wherein the step of determining a value of a KPI comprises determining the value of the KPI based on a value extracted [0077], but Stowell et al do not disclose the value of the KPI is extracted from a probe point. However, extracting the value of the KPI from a probe point would have been obvious to a person of ordinary skill in the art in order to locate business elements within a business process order to specify commitments in the context of business process management.

As per claim 7. The method of claim 3, wherein the step of evaluating a business commitment comprises evaluating a condition specified by the business commitment using the determined value of the KPI [Paragraph 0141].

As per claim 8, the method of claim 3, further comprising the step of commencing an

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action if it is determined that the business commitment has been violated [Paragraph 0093].

As per claim 9, the method of claim 8, wherein the step of commencing an action comprises providing notification of the violation to an entity associated with the business commitment. [Paragraph 0139].

As per claim 10, the method of claim 8, wherein the step of commencing an action comprises invoking a management directive to alter the execution of the business process [Paragraph 0030].

As per claims 11-20 are program storage device readable by a machine, for performing the steps of method claims 1-10; and therefore claims 11- 20 are rejected under the same rationale relied upon claims 1-10.

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 15, 2006

*Romain J. Leaty*  
Primary Examiner  
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